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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,180	12/08/2003	Nico N. Raczek	02/078 NUT	2906

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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/730,180

Applicant(s)

RACZEK ET AL.

Examiner

MICHAEL L. SHIPPEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1, 13 and 14 are rejected under 35 USC 112, first paragraph. The newly claimed concept of a mixture of compounds as set forth in embodiments (i) and (ii) lack description in the specification as filed. The examples are noted but, in the aggregate, do not amount to the same thing as now claimed. The examples are limited to a few specific species which are not equivalent to the now claimed generic concept. For example, there is no disclosure of compounds having various R<sub>2</sub> groups that are not hydrogen or compounds having the R<sub>2</sub> at various positions on the phenyl ring.

Claims 15 and 16 are rejected under 35 USC 112, first paragraph. The claim term "cation" lacks description in the specification as filed. Page 4 of the specification is noted but does not adequately support the term. Likewise, there is no basis for the concept of separating the compound from the corresponding "counterions". As set forth in the specification, the salt of the corresponding counter ions is separated rather than the counter ions themselves.

### ***Claim Rejections - 35 USC § 102***

Claims 17, 19, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,804,492 for reasons of record. While the reference does not recite the pH of the composition disclosed, there is no evidence that the prior art compositions are not within the claimed range.

Claims 17, 19, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,585,795 for reasons of record. While higher pHs may be preferred by the reference, the reference clearly teaches compositions within the claimed pH range, note Example 1. Moreover, the reference clearly teaches that pHs of  $\leq 5.0$ , note the first full paragraph of column 3. The recitation of an intended use is not seen to distinguish the claims from the prior art. For example, the reference suggest that the compounds may be used as solutions and the claimed compositions read on the same solutions regardless of an intended use recited in the claim.

***Claim Rejections - 35 USC § 103***

Claims 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,804,492 optionally in view of USP 3,361,794 for reasons of record. Applicants' discussion of the pH of the prior art compositions is noted but not found persuasive of patentability. First, there is no evidence that the prior art composition does not possess a pH within the claimed range. Moreover, it would appear that the pH of the prior art composition as not critical and it would be obvious to one of ordinary skill in the art that the prior compositions could possess a variety of pHs including pHs within the claimed range. Second, applicants' allegation of unexpected properties is unsubstantiated by any actual supporting evidence. There is no evidence that the claimed compositions possess any unexpected properties over the prior art composition. Third, the fact that applicants may have discovered an undisclosed advantage in an old composition does not lend patentability to the old composition.

Claims 1, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,804,492 optionally in view of USP 3,361,794 for reasons of record. The recitation of a specific alkyl mixture with respect to the R<sub>1</sub> alkyl group is not seen to distinguish the claims over the prior art. First, USP 4,804,492 clearly contemplated the use of quaternary ammonium groups wherein the alkyl group was a mixture, note the first full paragraph of column 4. Second, USP 3,361,794 teaches that the quaternary ammonium source having the specific alkyl mixture claimed is actually a commercial product (note Example II) and that such moieties possess a variety of properties in common with other such quaternary ammonium compounds. No patentable significance is seen in reciting a specific quaternary ammonium group that would be expected to possess a community of properties in compounds with the specific examples of the primary reference particularly wherein its source is actually a commercially available product.

Claims 17, 19, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,585,795 for reasons of record. Applicants' discussion of the pH of the prior art compositions is noted but not found persuasive of patentability. First, there is no evidence that the prior art composition does not possess a pH within the claimed range. It is clear that the prior contemplated compositions having a pH within the claimed range as pointed out above. Moreover, the reference is not limited to its preferred embodiments. Second, applicants' allegation of unexpected properties is unsubstantiated by any actual supporting evidence. There is no evidence that the claimed compositions possess any unexpected properties over the prior art

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composition. Third, the fact that applicants may have discovered an undisclosed advantage in an old composition does not lend patentability to the old composition.

Claims 1, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,585,795 optionally in view of USP 3,361,794 (*newly relied upon*). The recitation of a specific alkyl mixture with respect to the R<sub>1</sub> alkyl group is not seen to distinguish the claims over the prior art. First, USP 4,585,795 clearly contemplated the use of quaternary ammonium groups wherein the alkyl group was a mixture, note line 10 of column 2. Second, USP 3,361,794 teaches that the quaternary ammonium source having the specific alkyl mixture claimed is actually a commercial product (note Example II) and that such moieties possess a variety of properties in common with other such quaternary ammonium compounds. No patentable significance is seen in reciting a specific quaternary ammonium group that would be expected to possess a community of properties in compounds with the specific examples of the primary reference particularly wherein its source is actually a commercially available product.

Claims 1, 13, 14 and 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 3,361,794 for reasons of record. Applicants' discussion of the pH of the prior art compositions is noted but not found persuasive of patentability. First, there is no evidence that the prior art composition does not possess a pH within the claimed range. Moreover, it would appear that the pH of the prior art composition is not critical and it would be obvious to one of ordinary skill in the art that the prior compositions could possess a variety of pHs including pHs within the claimed range. Second, applicants' allegation of unexpected properties is unsubstantiated by any

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actual supporting evidence. There is no evidence that the claimed compositions possess any unexpected properties over the prior art composition. Third, the fact that applicants may have discovered an undisclosed advantage in an obvious composition does not lend patentability to the obvious composition.


### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **571-273-8300**.

MShippen  
August 18, 2005



**MICHAEL L. SHIPPEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1621**